

Applicants claim, in claim 1, a thermoplastic resin composition that comprises a transparent aromatic thermoplastic resin (a) and a copolyester resin (b). The copolyester resin (b) comprises at least two kinds of dicarboxylic acid moieties and at least one diol moiety. According to claim 1, the at least one diol moiety consists of at least one kind of diol moiety selected from aliphatic diol moieties, aromatic diol moieties, ethylene oxide adducts of aromatic diol moieties and combinations thereof. Further, 1 to 50 mol % of the dicarboxylic acid moieties is a naphthalenedicarboxylic acid moiety. Still further, the ratio of (a) to the combined amount of (a) and (b) is 55 to 99.99% by weight, and the ratio of (b) is 0.01 to 45% by weight. Applicants' transparent aromatic thermoplastic resin (a) shows a visible light transmittance of not less than 80% when molded into a 3 mm thick product.

The Harada reference, on the other hand, describes copolyesters in which the diol repeat unit is a mixture of ethylene glycol and 1,4-cyclohexanedimethanol repeat units. Thus, all of the resins recited by Harada require at least one alicyclic diol. As set out in claim 1, alicyclic diols are not included in the types of diol moieties claimed.

As provided in MPEP-2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Or stated another way, "The identical invention must be shown in as complete detail as is contained in the ... claims. *Richardson v Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ 2d. 1913, 1920 (Fed. Cir. 1989). Although identify of terminology is not required, the elements must be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

It is clear from the foregoing remarks that the above-identified claims are not anticipated by the Harada reference. Applicants teach a thermoplastic resin composition wherein copolyester resin (b) comprises at least two kinds of dicarboxylic acid moieties and at least one diol moiety, wherein the at least one diol moiety consists of at least one kind of diol moiety selected from aliphatic diol moieties, aromatic diol moieties, ethylene oxide adducts of aromatic diol moieties and combinations thereof.

Harada does not describe, either expressly or inherently, the diol moieties required by Applicants' claim 1. Rather, as set out above, Harada requires that at least one diol moiety is an alicyclic diol. Thus, claim 1 is not anticipated by Harada. Claims 2-6 and 8-28 depend from claim 1 and, likewise, are not anticipated by Harada.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 2142.

As set forth above, Harada does not teach or suggest all the claim limitations. Further, there is absolutely no suggestion or motivation to modify the Harada reference as required by Applicants' claim 1.

Further, Allen, Hirose and Mizutani do not remedy the deficiencies of the Harada reference. Rather, Allen, Hirose and Mizutani are cited merely to show methods of stabilizing polycarbonate/polyester blends.

Accordingly, claim 1 is patentable over Harada in view of Allen, Hirose and Mizutani. Claims 2-6 and 8-28 depend from claim 1 and, likewise, are patentable over Harada in view of Allen, Hirose and Mizutani.

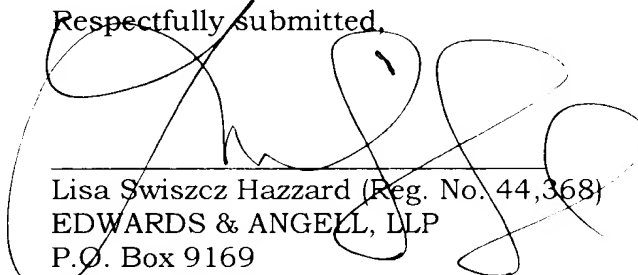
### **CONCLUSION**

In light of the above amendments, Applicant respectfully requests early consideration and allowance of the subject application.

If for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge Deposit Account No. **04-1105**.

Should the Examiner wish to discuss any of the amendments and/or remarks made herein, the undersigned attorney would appreciate the opportunity to do so.

Respectfully submitted,



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**VERSION WITH MARKINGS TO SHOW CHANGES MADE IN CLAIMS**

Please note that additions to the claims are shown underlined and deletions are shown in brackets.

Please amend claim 1 as follows:

1. A thermoplastic resin composition comprising:  
a transparent aromatic thermoplastic resin (a) and  
a copolyester resin (b) comprising at least two kinds of dicarboxylic acid moieties and at least one diol moiety, the at least one diol moiety consisting of at least one kind of [aliphatic] diol[s] moiety selected from aliphatic diol moieties, aromatic diol moieties, ethylene oxide adducts of aromatic diol moieties and combinations thereof, 1 to 50 mol %[d] of the dicarboxylic acid moieties being a naphthalenedicarboxylic acid moiety,  
the ratio of (a) to the combined amount of (a) and (b) being 55 to 99.99% by weight, and the ratio of (b) being 0.01 to 45% by weight, and  
said transparent aromatic thermoplastic resin (a) showing a visible light transmittance of not less than 80% when molded into a 3 mm thick product.